



Zpw
At

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	MAIL STOP APPEAL BRIEF
Marc Birkner et al.)	PATENTS
Application No.: 09/831,745)	Group Art Unit: 2132
Filed: September 20, 2001)	Examiner: JUNG W. KIM
For: METHOD AND DEVICE FOR)	Confirmation No.: 7104
CONTROLLING A PORTABLE)	
OBJECT LIFE CYCLE, IN)	
PARTICULAR, A SMART CARD)	

RESPONSE TO COMMUNICATION DATED NOVEMBER 17, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a Communication dated November 17, 2006, the supervisory patent Examiner asserts that the Appeal Brief filed October 24, 2006 fails to comply with two of the provisions of 37 C.F.R. §41.37.

First, the Communication alleges that the Brief does not comply with 37 C.F.R. §41.37(c)(1)(v). At page 4, lines 6-8, the Brief states that claim 1 recites that "the controlling means includes means for selectively enabling and/or inhibiting state transitions. This means comprises the check engine 9 in combination with the table 11 (page 11, lines 1-15)." The Communication states that it is not clear if the check engine in combination with the table corresponds to the controlling means, or to the means for selectively enabling and/or inhibiting state transitions. Appellants respectfully submit that, when section V of the Brief is considered as a whole, a person of ordinary skill in the art would understand the quoted passage to be referring to the means for selectively enabling and/or inhibiting the state transitions.

Specifically, at page 4, lines 2-5, the Brief states that the life cycle control device comprises means for controlling the transition from a first state to a second state of the portable electronic object. The Brief explains that "this means is generally embodied in the check engine 9, in combination with the tables 11, 12 and 13." Thus, the Brief clearly indicates that the controlling means corresponds to the check engine 9, in combination with all three of the tables 11, 12 and 13.

The Brief then goes on to state that the controlling means "includes" means for selectively enabling and/or inhibiting state transitions, i.e., the means for selectively enabling and/or inhibiting state transitions is one component of the controlling means. The Brief then identifies this component as being the check engine in combination with the table 11. This is confirmed by the reference to page 11, lines 1-15 of the specification. In particular, this cited passage states "the value of a box in the table of transitions 11...makes it possible to code either the absence of an enabled transition...or the enabling of a transition..."

Thus, given the fact that the structure corresponding to the controlling means had been previously identified in the Brief, and that the cited passage in the specification clearly indicates that the table 11 is associated with the enabling and/or inhibiting (absence of enabling) of transitions, the meaning of the passage identified in the Communication is submitted to be clear. There is no failure to comply with the requirements of 37 C.F.R. §41.37(c)(1)(v).

The Communication also asserts that the Brief does not present an argument under a separate heading for each ground of rejection on appeal, citing 37 C.F.R. §41.47(c)(1)(vii). In connection with this section, the Communication states "Applicant's Brief does not contain an argument for the rejections of claims 3, 7, 13,

15-19, 21-23 and 36-38. *Applicant must either present an argument for the rejections of these claims, or Applicant must withdraw these claims and depending claims"* (emphasis added). There is absolutely no basis in the rule for this assertion.

The rule requires that Applicant identify each ground of rejection that is presented for review. Such an identification appears at the bottom of page 6 of the Brief, where Appellants requested a review of the first and third grounds of rejection, namely the rejection of claims 1, 7, 10-17 and 36 under 35 U.S.C. §102, and the rejection of claims 4-6, 8 and 19-23 under 35 U.S.C. §103.

37 C.F.R. §41.37(c)(1)(vii) states that each ground of rejection must be treated under a separate heading. The first appealed ground of rejection is treated under heading VII.A., which begins on page 7 of the Brief. The second appealed ground of rejection appears under heading VII.B., which begins on page 10 of the Brief.

The allegation of non-compliance appears to be based upon two theories, neither of which are supported by the rule. First, the Communication appears to be asserting that an argument must be presented for every claim that has been rejected. There is no such requirement in the rule. In the present case, Appellants have chosen not to separately argue the rejections of certain dependent claims. Thus, Appellants are willing to let these dependent claims stand or fall in accordance with the Board's decision regarding their parent claims. Thus, for example, if the rejection of claim 1 is affirmed, the rejection of claim 3 would also stand, whereas if the rejection of claim 1 is reversed, the rejection of claim 3 is no longer supportable since it is based upon the rejection of claim 1.

The second theory underlying the allegation of non-compliance is that, if a particular ground of rejection is not appealed, that rejection is deemed to be proper.

Again, there is no support for this theory in the rule, and the Communication has not identified any other basis for such an allegation. The mere fact that Appellants have chosen not to separately argue the rejection of certain dependent claims does not mean that they concede that the rejection of those claims is proper. In the present case, the Appellants have appealed the rejection of the independent claims from which claims 3 and 18 depend. If the Board reverses the rejections of the parent independent claims, then the basis for the rejection of dependent claims 3 and 18 is removed. This is due to the fact that the rejection of the dependent claims incorporates the rejection of their parent claims.

In other words, the Board's treatment of the rejection of independent claims 1 and 12 will be dispositive of the status of dependent claims 3 and 18. As such, there is no reason to submit a separate argument for these dependent claims, if Appellants are willing to let them stand or fall with their parent claims.

In summary, 37 C.F.R. §41.37(c)(1)(vii) does not require the Appellant to present an argument for every claim, or every ground of rejection. It gives the Appellant the option to select the grounds of rejection to be reviewed by the Board, and which claims to argue under each selected rejection. In the present case, for the sake of brevity, Appellants have chosen only to argue the claims whose rejections will be controlling, with respect to the issues of interest to them. Appellants should not be penalized for choosing to limit their Brief to the principal issues, rather than arguing every detail.

For the foregoing reasons, it is respectfully submitted that the Appeal Brief filed October 24, 2006, is fully compliant with the requirements of 37 C.F.R. §41.37.

An Examiner's Answer, or other appropriate action, is submitted to be in order, and is respectfully solicited.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: December 1, 2006

By:

A handwritten signature in dark ink, appearing to read "James A. LaBarre", is written over a horizontal line.

James A. LaBarre
Registration No. 28632

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620